

## **REMARKS**

The Office Action dated June 4, 2003 has been carefully reviewed. Claims 1-20 are pending in this patent application. Reconsideration of this patent application, as amended, and in view of the following remarks, is respectfully requested.

### **I. Objection to the Abstract of the Disclosure (Specification)**

The Abstract of the Disclosure (Abstract) has been objected to by the Examiner for a minor informality contrary to MPEP §608.01(b). Particularly, the Examiner has objected to the use of the acronym "SCOT" alone.

The Abstract has been amended to delete the word "SCOT" and substitute the phrase "self-service checkout terminal (SCOT)" in place thereof.

In view of the above, Applicants respectfully submit that the Abstract is in proper form. Therefore, Applicants respectfully request withdrawal of the objection to the Abstract.

### **II. Objections to the Claims**

Claims 1-4, 6-8, 13, 15 and 20 were objected to for various informalities. Claims 1-4, 6-8, 13, 15 and 20 have been amended to correct the various informalities as suggested by the Examiner.

In view of the above, Applicants respectfully request withdrawal of the objections to the claims.

**III. Rejection of Claims 1-4, 8-9 and 15-16 Under 35 U.S.C. §103(a) (Swartz et al. & Bergman et al.)**

Claims 1-4, 8-9 and 15-16 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 5,594,228 issued to Swartz et al. (hereinafter, "Swartz") in view of U.S. Patent No. 5,469,142 issued to Bergman et al. (hereinafter, "Bergman"). Applicants respectfully submit that claims 1-4, 8-9 and 15-16 are not unpatentable over Swartz in view of Bergman. Particularly, there is not motivation to combine Bergman with Swartz to render claims 1-4, 6-8 and 15-16 obvious. Particularly, one skilled in the art would not be motivated to combine the teachings of Bergman with the teachings of Swartz as set forth herein.

**Applicants' Invention**

In summary, Applicants' invention is a retail terminal, such as a self-service or checkout retail terminal (SCOT), and a method of operation thereof. The retail terminal includes an electronic article surveillance (EAS) system. The EAS system includes an EAS detector and an EAS deactivator. The EAS detector is operative to detect an EAS tag on an item. The EAS deactivator is operative to deactivate an EAS tag.

EAS tag detection is associated with a purchase transaction event at the retail terminal, such as scanning or bagging an item. After EAS detection, the retail terminal directs the customer to deactivate the detected EAS tag. The

customer then utilizes the EAS deactivator to deactivate the EAS tag.

The subject invention eliminates the need to attempt to deactivate every item, thereby streamlining the self-checkout process.

Discussion re: Patentability of Independent Claim 1

*1. Claim 1*

Independent claim 1 reads as follows:

A method of operating a self-service checkout terminal comprising the steps of:  
allowing consumer scanning of an item for purchase via a scanner;  
determining, after successfully scanning the item, whether the item has an active electronic article surveillance tag; and  
allowing deactivation of the active electronic article surveillance tag by the consumer via an active electronic article surveillance tag deactivator after determining that the item has an electronic article surveillance tag.

*2. There is No Motivation to Combine Bergman With Swartz to Render Independent Claim 1 Obvious*

The Examiner has utilized Swartz as a main reference for teaching a self-checkout having a scanner, an electronic article surveillance deactivator, a processor and a memory. It is then admitted by the Examiner that "Swartz et al fails to teach or fairly suggest that the system further comprising [sic] an electronic article surveillance detector operative to detect whether a scanned item has an active electronic article surveillance tag, wherein the electronic article surveillance detector is associated with the scanner" (see 6/4/03 Office Action, page 4, third paragraph).

In order to attempt to alleviate the above-articulated shortcoming of Swartz, the Examiner utilizes Bergman. Particularly, the Examiner cites Bergman for teaching "an article surveillance detector for determining whether an

active electronic article surveillance tag is present at the checkout station" (see 6/4/03 Office Action, page 4, fourth paragraph).

"The test for obviousness is not whether the features of one reference may be bodily incorporated into another reference. ... Rather, we look to see whether combined *teachings* (emphasis original) render the claimed subject matter obvious." See *In re Wood*, 599 F. 2d 1032, 202 USPQ 171 (CCPA 1979). Moreover, the "test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Applicants respectfully submit that there is no motivation to combine the teachings of Bergman with the teachings of Swartz. Particularly, one skilled in the art would not be motivated to combine the teachings of Bergman with Swartz, since there is no need for the self-check apparatus of Swartz to ever incorporate a Bergman active electronic surveillance tag detector. Swartz assumes that a surveillance tag is present on the article because it is the surveillance tag that is being scanned. Swartz's invention revolves around the surveillance tag being on the article and having coded indicia thereon. In summation, without the surveillance tag, Swartz would not have an invention. The Swartz surveillance tag must therefore be part of the item

While the Examiner indicates that "it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate an electronic article surveillance detector as taught by Bergman at al into the teachings of Swartz et al in order to provide Swartz et al with a more advanced and power consumption system wherein the electronic article surveillance tag is detected or the purchased item has an active electronic article surveillance tag" (see 6/4/03 Office Action, page 4, last paragraph), Applicants respectfully contend that the teachings of Swartz and/or Bergman do not lead to the Examiner's above-articulated reason for modifying Swartz by Bergman.

Swartz teaches a self-check apparatus for processing a sales transaction of an article *having an attached surveillance tag*. Because Swartz is providing an apparatus specifically for processing articles already known to have a security tag, it would be pointless to provide the Swartz self-check apparatus with a security tag detector (i.e. an electronic article surveillance tag detector). Thus, although Bergman utilizes an electronic article surveillance tag detector, one skilled in the art would not be motivated to combine Bergman with Swartz because there is no teaching or suggestion for the combination.

As pointed out in the above-identified cases, it is not whether the Bergman electronic article surveillance tag detector can be incorporated into the self-check apparatus of Swartz, but whether one skilled in the art would be motivated to provide such a combination. Clearly, one skilled in the art would not be motivated to provide a piece of equipment (i.e. the Bergman electronic article surveillance tag detector) into another piece of equipment (i.e. the Swartz self-

check apparatus) when adding the piece of equipment would be superfluous or of no use to the other piece of equipment.

### *3. Conclusion*

Since it has been shown above that there is no teaching or suggestion to one skilled in the art to combine Bergman with Swartz, a prima facie case of obviousness under 35 U.S.C. § 103 has not been established with regard to the invention of claim 1. Accordingly, withdrawal of the rejection to claim 1 under §103(a) and allowance thereof is hereby respectfully requested.

#### Discussion re: Patentability of Claims 2-4

Each of claims 2-4 include independent claim 1 as a base claim. As a result, each of claims 2-4 is allowable for the reasons hereinbefore discussed with regard to claim 1. Moreover, each of claims 2-4 include additional limitations either not taught or suggested by Swartz and Bergman and/or wherein there is no teaching or suggestion to combine Bergman with Swartz. Therefore, each of claims 2-4 is further allowable over the cited art. Accordingly, withdrawal of the rejection to claims 2-4 under §103(a) and allowance thereof is hereby respectfully requested.

#### Discussion re: Patentability of Independent Claim 8

##### *1. Claim 8*

Independent claim 8, as amended, recites:

A self checkout comprising:

a scanner operative to scan an item;  
an electronic article surveillance detector operative to detect whether a  
successfully scanned item has an active electronic article surveillance tag; and  
an electronic article surveillance deactivator operative to deactivate the active  
electronic article surveillance tag after determining by the electronic article surveillance  
detector that a scanned item has the active electronic article surveillance tag.

*2. There is No Motivation to Combine Bergman With Swartz to Render  
Independent Claim 8 Obvious*

The reasoning regarding the patentability of independent claim 1 is  
applicable to the patentability of independent claim 8 and is hereby incorporated  
herein. Since it has been shown above that there is no teaching or suggestion  
supporting the combination of Swartz and Bergman to render the method of  
independent claim 1 obvious, it is axiomatic that the combination of Swartz and  
Bergman cannot render a self checkout apparatus as per independent claim 8  
operating in a like manner to the method of claim 1, obvious.

*3. Conclusion*

Since it has been shown above that there is no teaching or suggestion to  
one skilled in the art to combine Bergman with Swartz, a prima facie case of  
obviousness under 35 U.S.C. § 103 has not been established with regard to the  
invention of claim 8. Accordingly, withdrawal of the rejection to claim 8 under  
§103(a) and allowance thereof is hereby respectfully requested.

Discussion re: Patentability of Claim 9

Claim 9 includes independent claim 8 as a base claim. Claim 9 is  
allowable for the reasons hereinbefore discussed with regard to claim 8.

Moreover, claim 9 includes additional limitations not taught or suggested by Swartz and Bergman. Therefore, claim 9 is further allowable over the cited art. Accordingly, withdrawal of the rejection to claim 9 under §103(a) and allowance thereof is hereby respectfully requested.

Discussion re: Patentability of Independent Claim 15

*1. Claim 15*

Independent claim 15, as amended, recites:

A self checkout comprising:

- a processor;
- a scanner in communication with the processor;
- an electronic article surveillance detector in communication with the processor;
- an electronic article surveillance deactivator; and
- a memory in communication with the processor and storing program instructions which, when executed by the processor, causes the processor to: (a) allow scanning of an item for purchase via the scanner, (b) determine, after successful scanning of the item, whether the item has an active electronic article surveillance tag via the electronic article surveillance detector, and (c) allow deactivation of the active electronic article surveillance tag after determining that the item includes an electronic article surveillance tag.

*2. There is No Motivation to Combine Bergman With Swartz to Render Independent Claim 15 Obvious*

The reasoning regarding the patentability of independent claim 1 is applicable to the patentability of independent claim 15 and is hereby incorporated herein. Since it has been shown above that there is no teaching or suggestion supporting the combination of Swartz and Bergman to render the method of independent claim 1 obvious, it is axiomatic that the combination of Swartz and Bergman cannot render a self checkout apparatus as per independent claim 15 operating in a like manner to the method of claim 1, obvious.



### *3. Conclusion*

Since it has been shown above that there is no teaching or suggestion to one skilled in the art to combine Bergman with Swartz, a prima facie case of obviousness under 35 U.S.C. § 103 has not been established with regard to the invention of claim 15. Accordingly, withdrawal of the rejection to claim 15 under §103(a) and allowance thereof is hereby respectfully requested.

### Discussion re: Patentability of Claim 16

Claim 16 includes independent claim 15 as a base claim. Claim 16 is allowable for the reasons hereinbefore discussed with regard to claim 16. Moreover, claim 15 includes additional limitations not taught or suggested by Swartz and Bergman. Therefore, claim 16 is further allowable over the cited art. Accordingly, withdrawal of the rejection to claim 16 under §103(a) and allowance thereof is hereby respectfully requested.

### **IV. Rejection of Claims 5-7, 10-12 and 17-19 Under 35 U.S.C. §103(a) (Swartz et al., Bergman et al. & Bellis, Jr. et al.)**

Claims 5-7, 10-12 and 17-19 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Swartz as modified by Bergman, and further in view of US published patent application 2002/0,096,564 A1 issued to Bellis, Jr. et al. (hereinafter, "Bellis"). Applicants respectfully submit that claims 5-7, 10-12 and 17-19 are not unpatentable over Swartz, Bergman and Bellis. Particularly, the

combination of Swartz, Bergman and Bellis does not teach and/or suggest the limitations of claims 5-7, 10-12 and 17-19.

Discussion re: Patentability of Claims 5-7

Each of claims 5-7 includes independent claim 1 as a base claim. As such, the arguments regarding the patentability of independent claim 1 over Swartz and Bergman is applicable to the patentability of claims 5-7 and are hereby incorporated herein by reference.

It has been shown above that Swartz and Bergman do not render independent claim 1 obvious, since one skilled in the art would not be motivated to combine Bergman with Swartz. Bellis is cited by the Examiner for teaching a bagging station having an electronic article surveillance monitor for detecting the presence of an active electronic article surveillance tag by the security scale. There is no additional teaching or suggestion in Bellis that would suggest to one skilled in the art to combine Bergman and/or Bellis with Swartz as per the arguments for the patentability of independent claim 1. Absent such suggestion or teaching, the addition of Bellis cannot render claims 5-7 obvious.

Therefore, claims 5-7 are allowable for the reasons hereinbefore discussed with regard to independent claim 1. Withdrawal of the rejection to claims 5-7 is thus respectfully requested.

Discussion re: Patentability of Claims 10-12

Each of claims 10-12 includes independent claim 8 as a base claim. As such, the arguments regarding the patentability of independent claim 8 over Swartz and Bergman is applicable to the patentability of claims 10-12 and are hereby incorporated herein by reference.

It has been shown above that Swartz and Bergman do not render independent claim 8 obvious, since one skilled in the art would not be motivated to combine Bergman with Swartz. Bellis is cited by the Examiner for teaching a bagging station having an electronic article surveillance monitor for detecting the presence of an active electronic article surveillance tag by the security scale. There is no additional teaching or suggestion in Bellis that would suggest to one skilled in the art to combine Bergman and/or Bellis with Swartz as per the arguments for the patentability of independent claim 8. Absent such suggestion or teaching, the addition of Bellis cannot render claims 10-12 obvious.

Therefore, claims 10-12 are allowable for the reasons hereinbefore discussed with regard to independent claim 8. Withdrawal of the rejection to claims 10-12 is thus respectfully requested.

#### Discussion re: Patentability of Claims 17-19

Each of claims 17-19 includes independent claim 15 as a base claim. As such, the arguments regarding the patentability of independent claim 15 over Swartz and Bergman is applicable to the patentability of claims 17-19 and are hereby incorporated herein by reference.

It has been shown above that Swartz and Bergman do not render independent claim 15 obvious, since one skilled in the art would not be motivated to combine Bergman with Swartz. Bellis is cited by the Examiner for teaching a bagging station having an electronic article surveillance monitor for detecting the presence of an active electronic article surveillance tag by the security scale. There is no additional teaching or suggestion in Bellis that would suggest to one skilled in the art to combine Bergman and/or Bellis with Swartz as per the arguments for the patentability of independent claim 15. Absent such suggestion or teaching, the addition of Bellis cannot render claims 17-19 obvious.

Therefore, claims 17-19 are allowable for the reasons hereinbefore discussed with regard to independent claim 15. Withdrawal of the rejection to claims 17-19 is thus respectfully requested.

**V. Rejection of Claims 13-14 and 20 Under 35 U.S.C. §103(a) (Swartz et al., Bergman et al. & Garber et al.)**

Claims 13-14 and 20 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Swartz as modified by Bergman, and further in view of US Patent 6,486,780 issued to Garber et al. (hereinafter, "Garber"). Applicants respectfully submit that claims 13-14 and 20 are not unpatentable over Swartz, Bergman and Garber. Particularly, the combination of Swartz, Bergman and Garber does not teach and/or suggest the limitations of claims 13-14 and 20.

Discussion re: Patentability of Claims 13-14

Each of claims 13-14 includes independent claim 8 as a base claim. As such, the arguments regarding the patentability of independent claim 8 over Swartz and Bergman is applicable to the patentability of claims 13-14 and are hereby incorporated herein by reference.

It has been shown above that Swartz and Bergman do not render independent claim 8 obvious, since one skilled in the art would not be motivated to combine Bergman with Swartz. Garber is cited by the Examiner for teaching an electronic article surveillance system utilizing a coil/antenna. There is no additional teaching or suggestion in Garber that would suggest to one skilled in the art to combine Bergman and/or Garber with Swartz as per the arguments for the patentability of independent claim 8. Absent such suggestion or teaching, the addition of Garber cannot render claims 13-14 obvious.

Therefore, claims 13-14 are allowable for the reasons hereinbefore discussed with regard to independent claim 8. Withdrawal of the rejection to claims 13-14 is thus respectfully requested.

Discussion re: Patentability of Claim 20

Claim 20 includes independent claim 15 as a base claim. As such, the arguments regarding the patentability of independent claim 15 over Swartz and Bergman is applicable to the patentability of claim 20 and are hereby incorporated herein by reference.

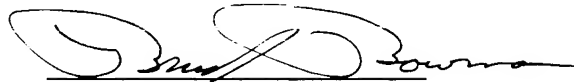
It has been shown above that Swartz and Bergman do not render independent claim 15 obvious, since one skilled in the art would not be motivated to combine Bergman with Swartz. Garber is cited by the Examiner for teaching an electronic article surveillance system utilizing a coil/antenna. There is no additional teaching or suggestion in Garber that would suggest to one skilled in the art to combine Bergman and/or Garber with Swartz as per the arguments for the patentability of independent claim 15. Absent such suggestion or teaching, the addition of Garber cannot render claim 20 obvious.

Therefore, claim 20 is allowable for the reasons hereinbefore discussed with regard to independent claim 15. Withdrawal of the rejection to claim 20 is thus respectfully requested.

**VI. CONCLUSION**

In view of the foregoing, it is submitted that this application is in condition for allowance. Therefore, Applicants respectfully request the withdrawal of the objection to the Abstract, objections and rejections to the claims, and an early allowance of all claims.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Bruce J. Bowman", written over a horizontal line.

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